

REMARKS

This is a full and timely response to the outstanding final Office Action mailed May 3, 2007 (Paper No. 20070426). Upon entry of this response, claims 1-11, 15-34, 37-44, 47-51, 54-57, 60-72, and 76-90 are pending in the application. In this response claims 37, 76, and 78 have been amended, claims 82-90 have been added, and claims 12-14, 35-36, 45-46, 52-53, 58-59, and 73-75 have been cancelled. Claims 12-14, 35-36, 45-46, 52-53, 58-59, and 73-75 are cancelled without prejudice, waiver, or disclaimer, and the rejection is therefore rendered moot. Applicants reserve the right to pursue the subject matter of these cancelled claims, or variants thereof, in a continuing application, if Applicants so choose, and do not intend to dedicate any of the cancelled subject matter to the public. Applicants respectfully request that the amendments being filed herewith be entered and request that there be reconsideration of all pending claims.

1. Rejection of Claims 1-4, 9, 16-17, 24, 26, 30-31, 34, 37-40, 45, 52-53, 60, 62, 66-67, 70, and 73-79 under 35 U.S.C. §102

Claims 1-4, 9, 16-17, 24, 26, 30-31, 34, 37-40, 45, 52-53, 60, 62, 66-67, 70, and 73-79 have been rejected under §102(e) as allegedly anticipated by *Ellis et al.* (U.S. 2002/0042913). To the extent that the rejection is not rendered moot by claim cancellation, Applicants respectfully traverse this rejection. A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

a. Claim 1

Applicants respectfully submit that *Ellis et al.* fails to teach, disclose or suggest at least “updating the download option proximately in time to when a change in download resources changes the availability of the download option” as recited in claim 1. The Office Action (p. 5) alleges that this feature is disclosed by “download option of FIG. 13, as well as FIG. 12.” This

same section of the Office Action also alleges that "Figs. 11-12 include a media list of download options and Fig. 13 shows a download option which specifically indicates that 'Raiders of the Lost Ark' is presently available for download." Thus, the Office Action appears to allege that each of the following corresponds to "the download option" recited in claim 1:

FIG. 11 of *Ellis et al.*: the media title 'Raider of the Lost Ark' (number 110)

FIG. 12 of *Ellis et al.*: the notification 'Raiders of the Lost Ark not presently available' (number 120)

FIG. 13 of *Ellis et al.*: the indicator 'S. Spielberg's Raiders of the Lost Ark is presently available' (number 130)

However, Applicants assert, for at least the following reasons, that none of these alleged "download options" are "updated" as recited in claim 1.

First, number 110 in FIG. 11 (the media title 'Raider of the Lost Ark') cannot correspond to "the download option" recited in claim 1, for at least the reason that claim 1 further recites "the download option comprising an indication of when the purchasable recordable media content may be downloaded" and media title 110 does not contain such an indication.

Next, even assuming, for the sake of argument, that the notification 120 corresponds to "the download option," *Ellis et al.* merely teaches that "region 120 may be displayed to inform the user of the lack of availability." (*Ellis et al.*, para. 57.) However, *Ellis et al.* does not teach that region 120 is "updated," because region 120 ("not available") is not even displayed before the lack of availability is determined. Instead, FIG. 11 is shown before lack of availability is determined. Thus, the display of region 120 is not an update, but an initial appearance of the alleged "download option."

Finally, even assuming, for the sake of argument, that the notification 130 corresponds to "the download option," *Ellis et al.* merely teaches that "the system may notify the user of the availability using notification indicator 130 of FIG.13, which may provide the user with an opportunity to access the media for viewing". (*Ellis et al.*, para. 57.) However, *Ellis et al.* does not teach that notification indicator 130 is "updated", because indicator 130 is not even

displayed before availability is determined. In fact, FIG. 13 appears to be a different screen than the screen of FIG. 12. Thus, the display of indicator 130 is not an update, but an initial appearance of the alleged “download option.”

For at least the reason that *Ellis et al.* fails to disclose, teach or suggest these features, Applicants respectfully submit that *Ellis et al.* does not anticipate claim 1. Therefore, Applicants request that the rejection of claim 1 be withdrawn.

b. Claim 37

Claim 37 has been amended to recite “providing a plurality of download options to a user, each of the download options comprising an indication of when the purchasable recordable media content may be downloaded.” Applicants respectfully submit that *Ellis et al.* fails to teach, disclose or suggest at least this feature as recited in amended claim 37. The Office Action (p. 5) appears to allege that either media title 110, region 120, or notification indicator 130 in *Ellis et al.* corresponds to a “download option.” Applicants submit, for reasons similar to those discussed above in connection with claim 1, that none of these features of *Ellis et al.* corresponds to a “download option” as recited in claim 37. Furthermore, even assuming, for the sake of argument, that region 120 or notification 130 does correspond to a “download option”, both region 120 and notification 130 are displayed as a singular occurrence to indicate that a single media title is or is not available. In contrast, amended claim 37 recites “a plurality of download options.”

For at least the reason that *Ellis et al.* fails to disclose, teach or suggest these features, Applicants respectfully submit that *Ellis et al.* does not anticipate claim 37. Therefore, Applicants request that the rejection of claim 37 be withdrawn.

c. Claim 76

As an initial matter, Applicants note that the Office Action (p. 9) states that “the limitations of Claim 76 are combinations of limitations from Claims 1, 4, and 31.” However, the

language used in claim 4 and claim 31 is not in fact the same as that in previously presented claim 76. To the extent that such differences appear, the rejection of claim 76 is improper.

Claim 76 has been amended to recite "adding a new download option to the list of provided download options... removing one of the provided download options from the list of download options." Applicants respectfully submit that *Ellis et al.* fails to teach, disclose or suggest at least this feature as recited in amended claim 76. Although Applicants do not concede that *Ellis et al.* discloses a "download option", *Ellis et al.* teaches at most a single download option (as explained above in connection with claim 37). Furthermore, FIGs. 11-13 show that media title 110, region 120 and indicator 130 are displayed at different times. Therefore, display of region 120 is not "adding a new download option to the list of provided download options" and display of indicator 130 is not "removing one of the provided download options from the list of download options."

For at least the reason that *Ellis et al.* fails to disclose, teach or suggest these features, Applicants respectfully submit that *Ellis et al.* does not anticipate claim 76. Therefore, Applicants request that the rejection of claim 76 be withdrawn.

d. Claim 78

As an initial matter, Applicants note that the Office Action (p. 9) states that "the limitations of Claim 76 are combinations of limitations from Claims 1, 4, and 31...Claim 78 corresponds to Claim 76." However, the language used in claim 4 and claim 31 is not in fact the same as that in previously presented claim 78. To the extent that such differences appear, the rejection of claim 76 is improper, and thus the rejection of claim 78 is also improper.

Claim 78 has been amended to recite "adding a new download option to the list of provided download options... removing one of the provided download options from the list of download options." Applicants respectfully submit that *Ellis et al.* fails to teach, disclose or suggest at least this feature as recited in amended claim 78. Although Applicants do not concede that *Ellis et al.* discloses a "download option", *Ellis et al.* teaches at most a single

download option (as explained above in connection with claim 37). Furthermore, FIGs. 11-13 show that media title 110, region 120 and indicator 130 are displayed at different times. Therefore, display of region 120 is not "adding a new download option to the list of provided download options" and display of indicator 130 is not "removing one of the provided download options from the list of download options."

For at least the reason that *Ellis et al.* fails to disclose, teach or suggest these features, Applicants respectfully submit that *Ellis et al.* does not anticipate claim 78. Therefore, Applicants request that the rejection of claim 78 be withdrawn.

e. Claims 2-4, 9, 16-17, 24, 26, 31, 34, 37-40, 60, 62, 66-67, 70, 73-75, 77, and 79

Since claims 1, 37, 76, and 78 are allowable, Applicants respectfully submit that claims 2-4, 9, 16-17, 24, 26, 31, 34, 37-40, 60, 62, 66-67, 70, 73-75, 77, and 79 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 2-4, 9, 16-17, 24, 26, 31, 34, 37-40, 60, 62, 66-67, 70, 73-75, 77, and 79 be withdrawn.

2. Rejection of Claims 18 and 54 under 35 U.S.C. §103

Claims 18 and 54 have been rejected under §103(a) as allegedly obvious over *Ellis et al.* (2002/0042913) in view of *Greenwood et al.* (5,568,181). The addition of *Greenwood et al.* does not cure the deficiencies of *Ellis et al.* discussed above in connection with independent claim 1. Therefore, claims 18 and 54 are considered patentable under any combination of these references. Furthermore, since claims 1 and 37 are allowable, Applicants respectfully submit that claims 18 and 54 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 18 and 54 be withdrawn.

3. Rejection of Claims 8 and 44 under 35 U.S.C. §103

Claims 8 and 44 have been rejected under §103(a) as allegedly obvious over *Ellis et al.* (2002/0042913) in view of *Schaffer et al.* (6,934,964). The addition of *Schaffer et al.* does not cure the deficiencies of *Ellis et al.* discussed above in connection with independent claim 1. Therefore, claims 8 and 44 are considered patentable under any combination of these references. Furthermore, since independent claims 1 and 37 are allowable, Applicants respectfully submit that claims 8 and 44 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of that claims 8 and 44 be withdrawn.

4. Rejection of Claims 5-7, 10-11, 15, 19, 21-22, 27, 32-33, 41-43, 46-47, 51, 55, 57-58, 63, and 68-69 under 35 U.S.C. §103

Claims 5-7, 10-11, 15, 19, 21-22, 27, 32-33, 41-43, 46-47, 51, 55, 57-58, 63, and 68-69 have been rejected under §103(a) as allegedly obvious over *Ellis et al.* (2002/0042913) in view of *Haddad* (5,555,441). To the extent that the rejection is not rendered moot by claim cancellation, Applicants traverse this rejection. The addition of *Haddad* does not cure the deficiencies of *Ellis et al.* discussed above in connection with independent claim 1. Therefore, claims 5-7, 10-11, 15, 19, 21-22, 27, 32-33, 41-43, 46-47, 51, 55, 57-58, 63, and 68-69 are considered patentable under any combination of these references. Furthermore, since independent claims 1 and 37 are allowable, Applicants respectfully submit that claims 5-7, 10-11, 15, 19, 21-22, 27, 32-33, 41-43, 46-47, 51, 55, 57-58, 63, and 68-69 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 5-7, 10-11, 15, 19, 21-22, 27, 32-33, 41-43, 46-47, 51, 55, 57-58, 63, and 68-69 be withdrawn.

5. Rejection of Claims 2-14 and 48-50 under 35 U.S.C. §103

Claims 2-14 and 48-50 have been rejected under §103(a) as allegedly obvious over *Ellis et al.* (2002/0042913) in view of *Haddad* (5,555,441) and *Hassell* (2004/0128685). To the extent that the rejection is not rendered moot by claim cancellation, Applicants traverse this rejection. The addition of *Haddad* and *Hassell* does not cure the deficiencies of *Ellis et al.* discussed above in connection with independent claim 1. Therefore, claims 2-14 and 48-50 are considered patentable under any combination of these references. Furthermore, since independent claims 1 and 37 are allowable, Applicants respectfully submit that claims 2-14 and 48-50 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully requests that the rejection of that claims 2-14 and 48-50 be withdrawn.

6. Rejection of Claims 20, 23, 56, and 59 under 35 U.S.C. §103

Claims 20, 23, 56, and 59 have been rejected under §103(a) as allegedly obvious over *Ellis et al.* (2002/0042913) in view of *Haddad* (5,555,441) and *Schaffa* (5,973,685). To the extent that the rejection is not rendered moot by claim cancellation, Applicants traverse this rejection. The addition of *Haddad* and *Schaffa* does not cure the deficiencies of *Ellis et al.* discussed above in connection with independent claim 1. Therefore, claims 20, 23, 56, and 59 are considered patentable under any combination of these references. Furthermore, since independent claims 1 and 37 are allowable, Applicants respectfully submit that claims 20, 23, 56, and 59 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of that claims 20, 23, 56, and 59 be withdrawn.

7. Rejection of Claims 25, 28-29, 61, 64-65, and 80-81 under 35 U.S.C. §103

Claims 25, 28-29, 61, 64-65, and 80-81 have been rejected under §103(a) as allegedly obvious over *Ellis et al.* (2002/0042913) in view of *Haddad* (5,555,441) and *Deshpande*

(6,987,728). Claims 80 and 81 are cancelled without prejudice, waiver, or disclaimer, and the rejection is therefore rendered moot. Applicants reserve the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the cancelled subject matter to the public. Applicants expressly reserve the right to present cancelled claims 80 and 81, or variants thereof, in continuing applications to be filed subsequent to the present application.

Applicants respectfully traverse the rejection of claims 25, 28-29, 61, and 64-65. The addition of *Haddad* and *Deshpande* does not cure the deficiencies of *Ellis et al.* discussed above in connection with independent claim 1. Therefore, claims 25, 28-29, 61, and 64-65 are considered patentable under any combination of these references. Furthermore, since independent claims 1 and 37 are allowable, Applicants respectfully submit that claims 25, 28-29, 61, and 64-65 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of that claims 25, 28-29, 61, and 64-65 be withdrawn.

8. Rejection of Claims 35 and 71 under 35 U.S.C. §103

Claims 35 and 71 have been rejected under §103(a) as allegedly obvious over *Ellis et al.* (2002/0042913) in view of *Hooper* (5,414,455) and *Hassell* (2004/0128685). To the extent that the rejection is not rendered moot by claim cancellation, Applicants traverse this rejection. The addition of *Hooper* and *Hassell* does not cure the deficiencies of *Ellis et al.* discussed above in connection with independent claim 1. Therefore, claims 35 and 71 are considered patentable under any combination of these references. Furthermore, since independent claims 1 and 37 are allowable, Applicants respectfully submit that claims 35 and 71 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 35 and 71 be withdrawn.

9. Rejection of Claims 36 and 72 under 35 U.S.C. §103

Claims 36 and 72 have been rejected under §103(a) as allegedly obvious over *Ellis et al.* (2002/0042913) in view of *Greenwood et al.* (5,568,181) and *Hassell* (2004/0128685). To the extent that the rejection is not rendered moot by claim cancellation, Applicants traverse this rejection. The addition of *Greenwood* and *Hassell* does not cure the deficiencies of *Ellis et al.* discussed above in connection with independent claim 1. Therefore, claims 36 and 72 are considered patentable under any combination of these references. Furthermore, since independent claims 1 and 37 are allowable, Applicants respectfully submit that claims 36 and 72 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of that claims 36 and 72 be withdrawn.

10. Official Notice

The Office Action has made the following allegations of Official Notice or well known (location in the Office Action and claim relevance noted in parenthesis):

(Page 6, pertaining to claim 4)...it is recognized or known to those of ordinary skill in the art that there is a finite or limited amount of bandwidth available as well as number of resources residing on a remote server that can be accessed or downloaded simultaneously.

(Page 10, pertaining to claim 18)...the Greenwood et al. reference specifically teaches that it is notoriously well known in the art of adding a download option from a remote server to a client that the availability may be based on the downstream bandwidth capacity, signaling support and/or server storage capacity.

(Page 12, pertaining to claim 7) The examiner takes Official Notice that it is notoriously well known in the art of downloading media from a remote server to a client to have an added download option available to the user as described above in claim 5.

(Page 15) As to claims 12-14...transmitting media content via an in-band file transmission and/or out-of-band file transmission is well known to those of ordinary skill in the art.

Applicants respectfully traverse these allegations of Official Notice and submit that the subject matter pertaining to these claims should not be considered well-known. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

If applicant adequately traverses the examiner's assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Applicants respectfully submit that in the context of the claim language, such a finding of well known art is improper at least given the added complexity associated with such features as described in claims 5-7, 15, 18, 41-43, 51 and 54. Furthermore, the teaching of a single reference does not make the teaching "well-known."

Accordingly, Applicants traverse the assertions with regard to Official Notice. Because of this traversal, the Office must support its findings with evidence, or withdraw the Official Notice determination.

11. Findings of Inherency

According to well-established Federal case law, "[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation." *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 1000 (Fed. Cir.

2006). Thus, Applicants respectfully traverse the allegations of inherency in the Office Action, as discussed below.

The Office Action (p. 6) alleges, with regard to claim 4, that "...the unavailability of media due to bandwidth constraints is inherent in any VOD-like system (such as the system of Ellis)..." Applicants respectfully disagree. Applicants respectfully submit that media may be unavailable in a VOD-like system for a variety of reasons, for example hardware limitations not necessarily due to bandwidth constraints. Additionally, not every VOD-like system is inherently limited by bandwidth constraints, for example there are a number of VOD-like systems on the internet that are not content limited due to bandwidth constraints.

The Office Action (p. 7) alleges, with regard to claim 24, that "...it is inherent in Ellis's system (i.e., pay-per-view) that some form of data structure contain the recited limitations..." Applicants respectfully disagree. The recited limitations do not necessarily have to be stored in a data structure: consider that the pricing information could be entered and changed by an administrator when requested by the user.

12. Newly Added Claims

Applicants submit that new claims 82-97 are allowable over the cited references. Specifically, independent claim 82 is allowable for at least the reason that the cited references do not teach, disclose, or suggest the feature of "providing a list of download options for a media content instance to a user, each download option comprising a content quality description and an indication of when the purchasable recordable media content may be downloaded." Independent claim 89 is allowable for at least the reason that the cited references do not teach, disclose, or suggest the feature of "a processor configured with the logic to provide a list of download options for a media content instance to a user, each download option comprising a content quality description and an indication of when the purchasable recordable media content may be downloaded." Claims 83-88 and 90-97 are allowable over the cited references for at

least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants request the Examiner to enter and allow the above new claims.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-11, 15-34, 37-44, 47-51, 54-57, 60-72, and 76-90 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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